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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
HAYES, JOHN W	

ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 12/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/472,197	GARDENSWARTZ ET AL.	
	Examiner	Art Unit	
	John W Hayes	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 September 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *85-90* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *85-90* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 29 September 2003 has been entered.

Status of Claims

2. Applicant has amended claims 85, 87 and 89 in the amendment filed 29 September 2003. Thus, claims 85-90 remain pending and are again presented for examination.

Response to Arguments

3 Applicant's arguments with respect to claims 85, 87 and 89 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 85-86 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Scroggie et al*, WO 97/23838 in view of *Laor*, U.S. Patent No. 6,076,069 and *Leville et al*, WO 98/21713 A2.

As per **Claim 85**, *Scroggie et al* disclose a database for storing information readable by a processor for facilitating the delivering a targeted advertisement, comprising a data structure including a field for storing a first identifier corresponding to a first computer associated with a consumer in the form of an e-mail address (Page 14 line 24-Page 15 line 10; Page 20 line 16-Page 21 line 30) and a second field for storing a second identifier associated with the first identifier and corresponding to an observed offline purchase history of the consumer, the purchase history including information of an offline purchase of the consumer collected at a point of sale when the offline purchase transpired (Page 6, lines 12-25; Page 19 line 15-Page 20 line 15). Although Scroggie et al teaches a first identifier corresponding to a first computer associated with a consumer in the form of an e-mail address, Scroggie et al, however, fails to specifically disclose that the first identifier identifies a specific computer. *Laor* discloses a method and system for distributing and redeeming electronic coupons and teaches that it has become common practice for a provider of information to use identifiers such as cookies as a means of identifying or recognizing a client and providing some pre-determined level of customization during subsequent requests (Col. 1, lines 23-40). Identifiers such as cookies and IP addresses were well known for use in identifying a specific computer at the time of applicant's invention. Thus, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to utilize cookie numbers as a means to identify a computer associated with a consumer since cookies were well known for providing this type of identification information. Thus, *Laor* provides motivation by indicating that cookies are commonly used to identify or recognize a client and providing some level of pre-determined and pre-programmed level of customization at the discretion of the information provider.

Scroggie et al further fails to explicitly disclose a third field for storing a purchase behavior classification associated with the observed offline purchase history and delivering a targeted advertisment based on the purchase behavior classification without having the processor access the offline purchase history. *Leville et al* disclose a merchandizing system substantially similar to applicants claimed invention

and teaches fields for storing purchase behavior classification associated with an observed offline purchase history (Figures 5-7; Page 2, lines 1-13; Page 3, lines 17-25; Col. 4, lines 8-12; Col. 5, lines 10-15; Page 7, lines 12-25; Page 13 line 17-Page 15, line 28). *Leville et al* further teaches automatically providing targeted advertisements to the user based on the purchase behavior classification without having the processor access the offline purchase history, but rather the purchase behavior classification or profile (Figures 5-7; Page 2, lines 1-13; Page 3, lines 17-25; Page 4, lines 8-12; Page 5, lines 10-15). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of *Scroggie et al* and include a field identifying the purchase behavior classification of the consumer as taught by *Leville et al* so that consumers could be targeted with specific incentives based on their associated behavior classification . The motivation would be to provide an advantage and benefit to the consumer in that they would be presented incentives that they would most likely be interested in. *Leville et al* provides motivation by indicating that using a consumer profile based on consumer purchasing behavior is particularly useful to product brand manufacturers and retailers for making decisions regarding product discount pricing and product promotions to be offered to specifically identified consumers to effect the purchasing behavior of the specially identified consumer (Page 2, lines 6-13).

As per **Claim 86**, *Scroggie et al* further disclose wherein the second identifier comprises a shopper card identification code of the consumer (Page 6, lines 12-25; Page 19 line 25-Page 20 line 5). *Scroggie et al* further discloses a first identifier corresponding to a first computer associated with a consumer by using an e-mail address identifier (Page 14 line 24-Page 15 line 10; Page 20 line 16-Page 21 line 30), however, fails to specifically disclose that the first identifier is a cookie number. *Laor* discloses a method and system for distributing and redeeming electronic coupons and teaches that it has become common practice for a provider of information to use cookies as a means of identifying or recognizing a client and providing some pre-determined level of customization during subsequent requests (Col. 1, lines 23-40). Thus, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to utilize cookie numbers as a means to identify a computer associated with a consumer since cookies were well known for providing this type of identification information. Thus, *Laor*

provides motivation by indicating that cookies are commonly used to identify or recognize a client and providing some level of pre-determined and pre-programmed level of customization at the discretion of the information provider.

6. Claim 87 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Scroggie et al*, WO 97/23838 in view of *Leville et al*, WO 98/21713 A2.

As per **Claim 87**, *Scroggie et al* disclose a field for storing a first identifier corresponding to a first computer and associated with an observed offline purchase history of a consumer, the purchase history including information of an offline purchase of the consumer collected at a point of sale when the offline purchase transpired (Page 19 line 14-Page 21 line 30). *Scroggie et al* fails to disclose a field for specifically storing a purchase behavior classification based on the purchase history and further automatically delivering the targeted advertisement based on the purchase behavior classification without having the processor access the offline purchase history. *Leville et al* disclose a merchandizing system substantially similar to applicants claimed invention and teaches fields for storing purchase behavior classification associated with an observed offline purchase history (Figures 5-7; Page 2, lines 1-13; Page 3, lines 17-25; Col. 4, lines 8-12; Col. 5, lines 10-15; Page 7, lines 12-25; Page 13 line 17-Page 15, line 28). *Leville et al* further teaches automatically providing targeted advertisements to the user based on the purchase behavior classification without having the processor access the offline purchase history, but rather the purchase behavior classification or profile (Figures 5-7; Page 2, lines 1-13; Page 3, lines 17-25; Page 4, lines 8-12; Page 5, lines 10-15). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of *Scroggie et al* and include a field identifying the purchase behavior classification of the consumer as taught by *Leville et al* so that consumers could be targeted with specific incentives based on their associated behavior classification . The motivation would be to provide an advantage and benefit to the consumer in that they would be presented incentives that they would most likely be interested in. *Leville et al* provides motivation by indicating that using a consumer profile based on consumer purchasing behavior is particularly useful to product brand

manufacturers and retailers for making decisions regarding product discount pricing and product promotions to be offered to specifically identified consumers to effect the purchasing behavior of the specially identified consumer (Page 2, lines 6-13).

7. Claims 89-90 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Scroggie et al*, WO 97/23838 in view of *Leville et al*, WO 98/21713 A2 and *Csaszar et al*, U.S. Patent No. 5,970,124.

As per **Claims 89-90**, *Scroggie et al* disclose a database for storing ID numbers corresponding to customers (Page 19 lines 14-30) and targeting purchase incentives to specific customers based upon the observed offline purchase history of the customer, the purchase history including information of a purchase of the customer collected at a point of sale when the purchase transpired (Page 20 line 9-Page 21 line 15) wherein the identifiers are readable by a processor for facilitating the delivery of the targeted advertisements.

Scroggie et al, however, fail to specifically disclose a field for storing a purchase behavior classification associated with the observed offline purchase history and delivering a targeted advertisment based on the purchase behavior classification without having the processor access the offline purchase history. *Leville et al* disclose a merchandizing system substantially similar to applicants claimed invention and teaches fields for storing purchase behavior classification associated with an observed offline purchase history (Figures 5-7; Page 2, lines 1-13; Page 3, lines 17-25; Col. 4, lines 8-12; Col. 5, lines 10-15; Page 7, lines 12-25; Page 13 line 17-Page 15, line 28). *Leville et al* further teaches automatically providing targeted advertisements to the user based on the purchase behavior classification without having the processor access the offline purchase history, but rather the purchase behavior classification or profile (Figures 5-7; Page 2, lines 1-13; Page 3, lines 17-25; Page 4, lines 8-12; Page 5, lines 10-15). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of *Scroggie et al* and include a field identifying the purchase behavior classification of the consumer as taught by *Leville et al* so that consumers could be targeted with specific incentives based on their associated behavior classification . The motivation would be to provide an advantage and benefit to

the consumer in that they would be presented incentives that they would most likely be interested in. *Leville et al* provides motivation by indicating that using a consumer profile based on consumer purchasing behavior is particularly useful to product brand manufacturers and retailers for making decisions regarding product discount pricing and product promotions to be offered to specifically identified consumers to effect the purchasing behavior of the specially identified consumer (Page 2, lines 6-13).

Scroggie et al further fail to specifically disclose an identifier corresponding to the targeted interactive voice response message. *Csaszar et al* disclose a database containing attributes of a consumer and targeted messages that an interactive voice response system can deliver to a consumer based on the consumer attributes (Abstract; Col. 1 line 61-Col. 2 line 7, Col. 2, lines 18-25 and Col. 2 line 51-Col. 3 line 5). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the database of *Scroggie et al* and include the capability to store identifiers for targeted messages and deliver these messages via an interactive voice response system to the consumer as an alternate means to present targeted advertisements to consumers who may not have access to a computer. *Csaszar et al* also provides motivation by indicating that an advantage of interactive voice response systems is that they can deliver information that consumers desire at any time and at low cost (Col. 2, lines 35-37).

8. Claim 88 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Scroggie et al*, WO 97/23838 and *Leville et al*, WO 98/21713 A2 as applied to claim 87 above, and further in view of *Laor*, U.S. Patent No. 6,076,069.

As per **Claim 88**, *Scroggie et al* further discloses a first identifier corresponding to a first computer associated with a consumer by using an e-mail address identifier (Col. 9, lines 29-40; Col. 12 line 53-Col. 13 line 23) however, fails to specifically disclose that the first identifier could be a cookie. *Laor* discloses a method and system for distributing and redeeming electronic coupons and teaches that it has become common practice for a provider of information to use cookies as a means of identifying or recognizing a client and providing some pre-determined level of customization during subsequent requests (Col. 1, lines

23-40). Thus, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to utilize cookie numbers as a means to identify a computer associated with a consumer since cookies were well known for providing this type of identification information. Thus, *Laor* provides motivation by indicating that cookies are commonly used to identify or recognize a client and providing some level of pre-determined and pre-programmed level of customization at the discretion of the information provider.

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 85-89 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 12 of U.S. Patent No. 6,298,330 B1 in view of Leville et al, WO 98/21713 and *Laor*, U.S. Patent No. 6,076,069.

As per Claims 85-89, although the conflicting claims are not identical, they are not patentably distinct from each other. Claim 12 of U.S. Patent No. 6,298,330 B1 recites all the limitations of claim 85 with the exception of a third field for storing the purchase behavior classification and automatically delivering the targeted advertisement without the having the processor access the offline purchase history. *Leville et al* disclose a merchandizing system substantially similar to applicants claimed invention and teaches fields for storing purchase behavior classification associated with an observed offline purchase history (Figures 5-7; Page 2, lines 1-13; Page 3, lines 17-25; Col. 4, lines 8-12; Col. 5, lines 10-

15; Page 7, lines 12-25; Page 13 line 17-Page 15, line 28). *Leville et al* further teaches automatically providing targeted advertisements to the user based on the purchase behavior classification without having the processor access the offline purchase history, but rather the purchase behavior classification or profile (Figures 5-7; Page 2, lines 1-13; Page 3, lines 17-25; Page 4, lines 8-12; Page 5, lines 10-15). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify claim 12 of U.S. Patent No. 6,298,330 B1 and include a field identifying the purchase behavior classification of the consumer as taught by *Leville et al* so that consumers could be targeted with specific incentives based on their associated behavior classification. The motivation would be to provide an advantage and benefit to the consumer in that they would be presented incentives that they would most likely be interested in. *Leville et al* provides motivation by indicating that using a consumer profile based on consumer purchasing behavior is particularly useful to product brand manufacturers and retailers for making decisions regarding product discount pricing and product promotions to be offered to specifically identified consumers to effect the purchasing behavior of the specially identified consumer (Page 2, lines 6-13).

Claim 12 of U.S. Patent No. 6,298,330 B1 further fails to recite wherein the first identifier is a cookie number. *Laor* discloses a method and system for distributing and redeeming electronic coupons and teaches that it has become common practice for a provider of information to use identifiers such as cookies as a means of identifying or recognizing a client and providing some pre-determined level of customization during subsequent requests (Col. 1, lines 23-40). Identifiers such as cookies and IP addresses were well known for use in identifying a specific computer at the time of applicant's invention. Thus, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to utilize cookie numbers as a means to identify a computer associated with a consumer since cookies were well known for providing this type of identification information. Thus, *Laor* provides motivation by indicating that cookies are commonly used to identify or recognize a client and providing some level of pre-determined and pre-programmed level of customization at the discretion of the information provider.

11. Claim 90 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 12 of U.S. Patent No. 6,298,330 B1, *Leville et al*, WO 98/21713 and *Laor*, U.S. Patent No. 6,076,069 as applied above, and further in view of *Csaszar et al*, U.S. Patent No. 5,970,124.

As per Claim 90, claim 12 of U.S. Patent No. 6,298,330 B1 fails to recite an identifier corresponding to the targeted interactive voice response message. *Csaszar et al* disclose a database containing attributes of a consumer and targeted messages that an interactive voice response system can deliver to a consumer based on the consumer attributes (Abstract; Col. 1 line 61-Col. 2 line 7, Col. 2, lines 18-25 and Col. 2 line 51-Col. 3 line 5). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify claim 12 of U.S. Patent No. 6,298,330 B1 and include the capability to store identifiers for targeted messages and deliver these messages via an interactive voice response system to the consumer as an alternate means to present targeted advertisements to consumers who may not have access to a computer. *Csaszar et al* also provides motivation by indicating that an advantage of interactive voice response systems is that they can deliver information that consumers desire at any time and at low cost (Col. 2, lines 35-37).

Conclusion

12. The prior art previously made of record and not relied upon is considered pertinent to applicant's disclosure.

- Merriman et al disclose the use of cookies and IP addresses to identify a computer associated with a consumer
- Weinblatt discloses a technique for correlating purchasing behavior of a consumer to advertisements
- Golden et al disclose an interactive marketing network using electronic certificates and monitors redemption of consumer certificates however does not disclose an identifier corresponding to a consumer's computer

- Powell [5,806,044] disclose a method and system for distributing coupons through a computer network wherein advertisements/coupons are e-mailed to customers and wherein customers possess a shopper card, however, purchases at a POS device are not monitored
- O'Brien et al disclose an apparatus for selective distribution of coupons based on prior customer behavior and target distribution of coupons at the checkout counter, however, does not teach transmitting coupons to customers via a customer's computer
- Jovicic et al disclose an electronic coupon communication system and teaches the storage of both a customer ID and user's E-Mail address for sending electronic coupons to customers. Also teaches the storage of redemption of coupons by each customer
- Day et al disclose a system for offering targeted discounts to consumers and teach the tracking of customer purchases via the use of a shopper's card, customer IDs, targeted ads based on shopping behavior via an in store kiosk
- Engel et al disclose an electronic coupon distribution system for distributing electronic coupons to customers via their computer and the system may be used to obtain additional information about the customer for future marketing purposes
- Ono et al disclose a system for sales promotions based on the purchase history of consumers
- Anderson et al disclose a system for analyzing consumer purchasing information based on product and consumer clustering relationships wherein consumers are organized into clusters based on common consumer demographics and other characteristics
- Kepecs discloses a system for distributing and reconciling electronic coupons and teaches that coupons are distributed to consumers through the Internet and wherein an account is maintained for consumers using a unique key such as is used in shopper cards
- Scroggie et al [6,014,634] disclose a system and method for providing shopping aids and incentives to consumers through a computer network and further teaches the use of personalized web pages for consumers for transmitting the incentives based on consumer shopping history

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hayes whose telephone number is (703)306-5447. The examiner can normally be reached Monday through Friday from 5:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington D.C. 20231

or faxed to:

(703) 872-9306 [Official communications; including After Final communications labeled "Box AF"]

(703) 746-5531 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

John W. Hayes
Primary Examiner
Art Unit 3621

December 18, 2003